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TAREK N FAHMI  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
7TH FLOOR  
12400 WILSHIRE BOULEVARD  
LOS ANGELES, CA 90025

EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

2165

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/328,983

Applicant(s)

WALLGREN ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4. 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the terms "sufficient" in line 2 and "sufficiently" in line 3 renders the claim(s) indefinite because the claim(s) include(s) elements (those encompassed by "sufficient" and "sufficiently"), render the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Since claims 2-4 are dependencies of claim 1, they inherit the deficiencies of claim 1 and therefore they are rejected similarly.

3. Claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. With regards to claim 15, the omitted structural cooperative relationships are: relationship between Web server 52 and customers 54 and their interface 60, vendor/service providers 56a and 56b and their interface 62, and

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notification engine 66. Since claims 16-20 are dependencies of claim 15, they inherit the deficiencies of claim 15 and therefore they are rejected similarly.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 5-11 and 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility. Claims 5 and 12 merely recite non-functional descriptive material. Moreover claim 5 appears to be a method claim without any method steps. The phrase, "to allow..... a task description for a custom manufacturing project .....each iteration", suggests method terminology. Since claims 6-11 and 13-14 are dependencies of claims 5 and 12 respectively they inherit the deficiencies of claims 5 and 12 respectively and are therefore rejected similarly.

Claims 5-11 and 12-14 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed inventions of claims 5 and 12 are not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed inventions. Since claims 6-11 and 13-14 are dependencies of claims 5 and 12

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respectively, they inherit the deficiencies of claims 5 and 12 and are therefore rejected similarly.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-2, 4-13 and 15-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Conklin et al. (US Patent 6,141,653).

With regards to claims 1-2, and 4, Conklin teaches a computer-based method, comprising collecting, through a series of iterative customer submissions and vendor responses, sufficient information concerning a custom manufacturing project so as to

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produce a sufficiently constrained job request as to allow at least one of the vendors to submit a quote for the project, wherein the submissions and responses are made through Web forms collecting comprises incrementally adding constraints to an initially under-constrained job request to produce the sufficiently constrained job request ( col.13, line 65-col.26, line 18, "*.....multivariate negotiations engine for iterative bargaining.....buyers and sellers.....propose and negotiate orders and counteroffers....For example, manufacturers in the computer industry..... .Special orders for samples.....The seller selects from several Website format templates.....Still in Fig.1k, ....buyer might either propose negotiation of order terms...send out a request for proposal (RFP) to all or some of the seller's ....each seller can offer...with the ability to make e-mail enquiries.....*").

With regards to claims 5-11, Conklin teaches a computer-based service configured to allow a customer and one or more vendors to interact with one another in defining a task description for a custom manufacturing project by permitting the customer to specify, in an initially under constrained fashion, the task description including payment and delivery terms and further permitting the vendors and the customer to successively develop the task description to a fully constrained form through an iterative process in which one or more constraints on the task description are added, removed and/or modified during each iteration, and varying information regarding the task description on a vendor-by-vendor basis, through a series of notification messages transmitted via a Web server, storing vendor-specific instances of

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the task description, each accessible by the customer, providing vendor and customer - specific views of the initially underconstrained task description specified by the each other (col.13, line 65-col.26, line 18, "*.....multivariate negotiations engine for iterative bargaining.....buyers and sellers.....propose and negotiate orders and counteroffers....For example, manufacturers in the computer industry..... .Special orders for samples.....The seller selects from several Website format templates.....Still in Fig.1k, ....buyer might either propose negotiation of order terms...send out a request for proposal (RFP) to all or some of the seller's ....each seller can offer...with the ability to make e-mail enquiries..... .Note: Conklin discloses that the iterative negotiations cover all terms and conditions of a transaction and not only the price and these terms are negotiated in stages. The various terms and conditions of the transactions in Conklin relate to constraints in the claim, see col.14, lines 27-30, col.19, lines 58-66 and col.25, lines 12-59).*

With regards to claims 12-13, Conklin teaches a computer-based task description, which could be a custom manufacturing job, comprising a set of constraints arrived at through an iterative process in which a customer and one or more vendors successively define criteria for completing the task defined by the description, the criteria including payment and delivery terms sufficient to support a binding contractual obligation (col.13, line 65-col.26, line 18, "*.....multivariate negotiations engine for iterative bargaining.....buyers and sellers.....propose and negotiate orders and counteroffers....For example, manufacturers in the computer industry..... .Special*

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*orders for samples.....The seller selects from several Website format templates.....Still in Fig.1k, ....buyer might either propose negotiation of order terms...send out a request for proposal (RFP) to all or some of the seller's ....each seller can offer...with the ability to make e-mail enquiries.....* Conklin discloses that the iterative negotiations cover all terms and conditions of a transaction and not only the price and these terms are negotiated in stages. The various terms and conditions of the transactions in Conklin relate to constraints in the claim, see col.14, lines 27-30, col.19, lines 58-66 and col.25, lines 12-59).

With regards to claims 15-20, Conklin discloses a Web server configured to allow a customer and one or more vendors to define one or more instances of a task description for a custom manufacturing project by permitting the customer to specify, in an initially under constrained fashion, the task description and further permitting the vendors and the customer to successively develop the task description to a fully constrained form through an iterative process in which one or more constraints on the task description are added, removed and/or modified during each iteration and further allowing to add and view them on their interfaces and also allowing customer to compare specific instances from one or more vendors, remove and/or modify the task description through the use of Web forms, providing notification messages to the customer and the vendors as appropriate, upon an indication that at least one of the instances of the task description has been modified in some (col.13, line 65-col.26, line 18, "*.....multivariate negotiations engine for iterative bargaining.....buyers and*



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*sellers.....propose and negotiate orders and counteroffers....For example, manufacturers in the computer industry..... .Special orders for samples.....The seller selects from several Website format templates.....Still in Fig.1k, ....buyer might either propose negotiation of order terms...send out a request for proposal (RFP) to all or some of the seller's ....each seller can offer...with the ability to make e-mail enquiries.....* Conklin discloses that the iterative negotiations cover all terms and conditions of a transaction and not only the price and these terms are negotiated in stages. The various terms and conditions of the transactions in Conklin relate to constraints in the claim, see col.14, lines 27-30, col.19, lines 58-66 and col.25, lines 12-59).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin in view of Gottfreid (US Patent 6,076,076).

With regards to claims 3 and 14, Conklin teaches a computer-based method,

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comprising collecting, through a series of iterative customer submissions and vendor responses, sufficient information concerning a custom manufacturing project or task so as to produce a sufficiently constrained job request as to allow at least one of the vendors to submit a quote for the project or task as disclosed in claims 1 and 12.

Conklin fails to teach that custom manufacturing project or task comprises a print job. It is a well-known fact that print jobs are ordered on line. Gottfried teaches ordering custom print jobs on line (abstract, "...*printing services are obtained and provided using remote and host computers....*", and col.1, line 39-col.7, line 30). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to include the concept of placing orders for print jobs. Doing so would present several benefits as suggested by Goottfried (col.3, lines 8-47, "...The invention has a large number of benefits associated....can be easily distributed.....provide unlimited access points.....").

### **Conclusion**

10 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) US Patent 6,055,519 to Kennedy et al. Teaches a computer-implemented system and process for negotiation and tracking of sale of goods on-line. Kennedy discloses a negotiation engine to allow negotiations through multiple states over a range of price, delivery dates, range of quantities, range of configuration of goods (col.2, line

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20-col.8, line 6, and col.13, line 21-col.14, line 65). The disclosure of this patent can be used to reject claims 1-2, 4-13 and 15-20.

(ii) US Patent 5,809,144 to Sirbu et al. Discloses a method for purchasing and delivering goods over a network involving negotiations before finalizing the contract (abstract and col.4, line 38-43).

(iii) EP 0886206A2 to Gase et al. discloses receiving print jobs over Internet from a number of client processors (abstract).

(iv) JP10063725 A to Matsushita Denki discloses a computer-based system connected to Internet negotiates bargains for price of goods and sale period of goods (abstract).

(v) Anonymous, " Buying a car on-line ", Successful Meetings; Philadelphia; Oct 1998 extracted from Internet on 04/04/2002 from web site:  
<http://www.proquest.umi.com/pqdweb?TS>. This article discloses the capabilities of doing car research and price negotiations on-line before purchasing the car.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-


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746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yogesh C Garg  
Examiner  
Art Unit 2165

YCG  
April 4, 2002

  
WYNN COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100